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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,523	09/01/2006	Yoshiyuki Asahina	10993.0282	2959
22852	7590	03/28/2011		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER	
			SERGENT, RABON A	
			ART UNIT	PAPER NUMBER
			1765	
			MAIL DATE	DELIVERY MODE
			03/28/2011 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,523

Applicant(s)

ASAHINA ET AL.

Examiner

Rabon Sergeant

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 17, 2010 has been entered.
2. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Firstly, despite applicants' remarks, adequate support has not been provided for the trihydric polyesterpolyol species now set forth within claim 1. Applicants have stated that support for the amendments can be found within paragraphs [0010], [0011], [0015], [0033], and [0035], and the examiner has reviewed these paragraphs; however, the subject matter of paragraphs [0033] and [0035] pertain to the reactants used to make the coating by reacting the polyols disclosed therein with the polyisocyanate composition; the polyols of these relied upon paragraphs are not used to produce the polyisocyanate composition. The polyols used to produce the polyisocyanate composition are set forth within paragraphs [0013] and [0014] of the specification and it is not seen that these paragraphs disclose the claimed trihydric polyesterpolyol.

3. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, with respect to claim 1, the language, as amended within line 14 (formula (I) constituting one line), is not understood. The language reads, “R is a residue excluding isocyanate group in the polyisocyanate composition derived from hexamethylene diisocyanate, isophorone diisocyanate and a polyol selected from the group consisting of trimethylolpropane and trihydric polyesterpolyol having a number average molecular weight of less than 300 and the polyol are bonded through an allophanate bond ...”. Specifically, the language, “and the polyol are bonded”, is not understood; it is unclear why “the diisocyanate” has been deleted and it is unclear if “polyol” should be plural. Clarification of the language is required.

Secondly, with respect to claim 3, the range of 3-8 fails to further limit claim 1, because the polyol species of claim 2 are limited to a functionality of 3.

Thirdly, with respect to claim 8, in view of the species recited within amended claim 1, the Markush groups, as set forth within claim 8, create ambiguity with respect to the scope of the claims and fail to further limit claim 1.

4. The prior art rejection has been withdrawn in view of applicants’ amendment limiting the polyol component to trimethylolpropane or trihydric polyesterpolyol having a molecular weight of less than 300. Despite applicants’ argument regarding the claimed polyol component concentration, it is noted that Table 1 (Table 1 was referenced within the previous Office action) of Asahina et al. discloses several examples employing quantities of diisocyanate and

polyhydroxyl compound that yield a polyol component concentration within applicants' claimed range; however, the polyols employed within the reference are required to have a functionality of 4.5 to 10, and, furthermore, polymeric polyols disclosed within the reference are disclosed as preferably having a number average molecular weight of 500 to 5,000. Accordingly, these two features distinguish Asahina et al. from the instant claims.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1765